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| WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP | | | EXAMINER | |
| 1250 CONNECTICUT AVENUE, NW | | | COPPOLA, JACOB C | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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| Office Action Summary | Application No. 10/563,230 | Applicant(s) ERNST ET AL. |
| | Examiner JACOB C. COPPOLA | Art Unit 3621 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 08 December 2008.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-35 is/are pending in the application.

4a) Of the above claim(s) 12-35 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-11 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/DP/0656) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This action is in reply to the “Response to Restriction Requirement” filed on 08 December 2008, hereinafter “08 Restriction Response.”
2. Claims 1-35 are currently pending.
3. Claims 1-11 have been examined.
4. Claims 12-35 have been withdrawn (see ¶ 9 below).
5. All references to the capitalized versions of “Applicants” refer specifically to the Applicants of record. Any references to lower case versions of “applicant” or “applicants” refer to any or all patent “applicants.” Unless expressly noted otherwise, references to “Examiner” refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally. The notations in this paragraph apply to this Office Action and any future office action(s) as well.
6. This Office Action is given Paper No. 20090217. This Paper No. is for reference purposes only.

Restrictions

7. Applicants’ election with traverse of claims 1-11 in the 08 Restriction Response is acknowledged. First, the traversal is on the grounds that “the restriction requirement is not based on the unity of invention.” The Examiner respectfully disagrees. The Examiner has based the restriction requirement on unity of invention. Second, the traversal is on the grounds that “the common inventive features for all groups of claims thus lie in acquiring/being able to acquire

and using/being able to use specific data related to network terminating units, in particular the calling party number, the called number of a service provider in combination with the transmission of decryption codes for freely transmitted encrypted program contents.” This is not found persuasive.

- a. As stated in MPEP §1850 II, “unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features.” Additionally, as stated in PCT Rule 13.2, “[t]he expression ‘special technical features’ shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.” Accordingly, the ability to acquire and use the underlying data, such as a “calling party number,” is not considered a “special technical feature” that provides a technical relationship among the claimed inventions.
8. The requirement is still deemed proper and is therefore made FINAL.
9. Claims 12-35 are withdrawn from further consideration pursuant to 37 C.F.R. §1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claim Objections

10. Claim 1 is objected to because of the following informalities:
 - b. It appears that Applicants intend to claim four method steps. However, as currently recited, the method only contains one action of “[e]stablishing.” If Applicants intend the other recitations to be actions (*i.e.*, method steps), the Examiner suggest amending the claim to recite the other actions involved. For example, the first step

recites “setup of a connection to a service provider.” The Examiner suggests amending the claim to recite ‘*connecting* to a service provider’ or ‘*making* a connection to a service provider.’ These are examples only. Appropriate correction is required.

c. This claim recites “network terminating units (terminals).” The use of parenthesis confuses the claim. The claim should recite either ‘network terminating units’ OR ‘terminals.’ Appropriate correction is required.

d. The labels “a),” “b),” “c),” and “d)” are used in this claim to enumerate the steps. These labels are unnecessary and should be removed. Appropriate correction is required.

e. The first word in each step (i.e. “Setup,” “Determination,” “Transmission,” and “Establishing”) is capitalized. Because these words do not begin new sentences, each word should begin with a lower case letter. Appropriate correction is required.

f. This claim recites “the calling party *number*” and “the called *no.* of the service provider” [emphasis added by the Examiner]. When drafting claims, abbreviations should not be used and consistency in language should be upheld. Accordingly, “no.” should read ‘number.’

Claim Rejections - 35 USC § 112, 2nd Paragraph

11. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-11 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

13. Regarding claim 1:

g. This claim recites “[s]etup of a connection to a service provider by a customer via his subscriber network.” This claim is indefinite because it is unclear to what “his” refers to.

h. This claim recites “the network terminating units,” “the calling party number,” “the called no. of the service provider,” and “the decryption code.” This claim is indefinite because these phrases lack antecedent basis in the claim.

i. This claim recites “[d]etermination of the network terminating units” and “[e]stablishing of billing data using the network terminating unit.” This claim is indefinite because it is unclear which one of the *plural* terminating units, previously determined, establishes the billing data.

j. This claim recites “[d]etermination of the network terminating units, in particular the calling party number... and the called no. of the service provider.” This claim is indefinite because it is unclear how a “calling party number” is determined as a “network terminating unit.” Likewise, the claim is indefinite because it is unclear how a “called no. of the service provider” is determined as a “network terminating unit.”

14. Regarding claim 6:

k. This claim recites “wherein the decryption code is generated specifically for the identified decoder and transmitted to *this*” [emphasis added by the Examiner]. This claim is indefinite because it is unclear to *what* the decryption code is transmitted.

15. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1-5 and 8-11, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Hylton et al. (U.S. 5,613,191 A) (“Hylton”).

18. Regarding claim 1:

1. Hylton discloses the following limitations:

i. *setup of a connection to a service provider by a customer via his subscriber network* (c. 16, l. 6-35; and c. 17, l. 28-32);

- ii. *determination of the network terminating units (terminals) of the existing connection, in particular the calling party number of the customer and the called no. of the service provider* (c. 16, l. 19-35 and l. 54-65);
- iii. *transmission of the decryption code for a program content* (c. 22, l. 20-37);
- iv. *establishing of billing data using a network terminating unit (terminal), in particular the calling party number, the called no. of the service provider, and information about the requested program content* (c. 15, l. 30-52).

m. Hylton does not directly disclose that the “establishing of billing data” is performed “using *the* network terminating unit” [emphasis added by the Examiner]. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include in the terminating unit of Hylton the function of establishing of billing data as taught by Hylton’s HDT 1180 since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

19. Regarding claims 2-5 and 8-11, Hylton discloses the limitations of claim 1, as shown above. Hylton, further, discloses the following limitations:

- n. *Claim 2: Method according to Claim 1, wherein the setup of the connection by the customer is executed by the dialing of a call number of the service provider and the acceptance of the telephone call by the service provider* (c. 2, l. 30-38; and c. 16, l. 19-35 and l. 54-65);

- o. *Claim 3: Method according to Claim 1, wherein at least one additional identification feature is retrieved from the caller during the period of the telephone call and before the transmission of the decryption code (c. 16, l. 54-65);*
- p. *Claim 4: Method according to Claim 3, wherein the validity of the identification features is checked, and the decryption code is transmitted only in the case of validity (c. 16, l. 54-65; and c. 22, l. 20-37);*
- q. *Claim 5: Method according to Claim 3, wherein the additional identification features include at least one of the following: an age-related or personal identification code, an identification or device number of a decoder receiving the decryption code (c. 16, l. 19-35; and c. 16, l. 54-65);*
- r. *Claim 8: Method according to claim 1, wherein the program content for which the decryption code is to be sent is queried before the transmission of the decryption code (c. 22, l. 20-37);*
- s. *Claim 9: Method according to claim 1, wherein at least one of the following items of information is stored for the billing data, or forwarded to a corresponding billing unit: the called number, the time and/or duration of the telephone connection, the additional identification features and/or the transmitted decryption code (c. 7, l. 30-56);*
- t. *Claim 10: Method according to claim 1, wherein the billing data is forwarded to the telecommunication service provider for collection (c. 7, l. 30-56); and*
- u. *Claim 11: Method according to claim 1, wherein the called number is a service number, which is billed via the telecommunication service provider (c. 7, l. 30-56).*

20. Claims 6 and 7, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Hylton, in view of Official Notice.

21. Regarding claims 6 and 7:

v. Hylton discloses the limitations of claims 1 and 4, as shown above. Hylton does not directly disclose the limitations:

v. *wherein the decryption code is generated specifically for the identified decoder and transmitted to this; and*

vi. *wherein the information about the identified calling party number is integrated in the decryption code.*

w. However, the Examiner takes Official Notice that generating a decryption code based on properties of a device is old and well-known in the art because this allows for the decryption code to be used by only the device with those properties.

x. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to generate the decryption code of Hylton using the calling number of the device of Hylton in order to limit the decryption code to that device.

22. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

23. After careful review of the original specification, the Examiner is unable to locate any lexicographic definitions with the required clarity, deliberateness, and precision.
24. Because the examined claims recite neither “step for” nor “means for”, the examined claims fail Prong (A) as set forth in MPEP §2181. Because all examined claims fail Prong (A) as set forth in MPEP §2181, the Examiner concludes that all examined claims do not invoke 35 U.S.C. §112, 6th Paragraph.

Conclusion

25. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work, Millennium Ed. By Ron White; How Networks Work, Bestseller Ed. By Frank J. Derfler et al.; How the Internet Works, Millennium Ed. By Preston Gralla; and Desktop Encyclopedia of the Internet by Nathan J. Muller, is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety. Moreover, because these references are directed towards beginners (see e.g. “User Level Beginning...”), because of the references’ basic content (which is self-evident upon examination of the references), and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that these references are primarily directed towards those of low skill in this art. Because these references are directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within theses references.

26. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure (see attached form PTO-892).
27. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.
28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/JACOB C. COPPOLA/
Patent Examiner, Art Unit 3621
February 18, 2009

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621